

BRIEF IN SUPPORT OF PETITION.

THE FACTS.

The depositions, testimony and exhibits received in evidence in the case established, without contradiction by the Commissioner, the following facts:

1. The mark "Old English" has been used by Petitioner and its predecessors as a trade-mark for cheese since the year 1912 (App. 31).

2. The mark "Old English" has been written in a kind of type known as "Old English" (See App. 44) as shown in the trade-mark drawing (App. 43) and in the various wrappers and packages (Plaintiff's Exhibits 1 to 11, incl.) continuously since at least as early as the year 1920. No other style or type or lettering has been used since that date (App. 24).

3. The cheese sold under this brand by Petitioner is Kraft Cheese Company's "top brand" of cheese (App. 7 and 13). This brand of cheese is not now available for general sale because of Army and Navy and Lend-Lease requirements, which make it impossible for Petitioner to obtain high-grade well-cured cheese for the purpose of manufacturing cheese worthy of being sold under the "Old English" label (App. 10-11).

4. Before the present emergency developed, Petitioner was manufacturing and selling this high-grade cheese under the "Old English" label in large quantities throughout the United States. During the eight years prior to 1942, the sales exceeded five million (5,000,000) pounds annually (App. 33).

5. "Old English" brand cheese sells for a considerably higher price than any other cheese of similar type put out by Petitioner (App. 21).

6. The words "process cheddar cheese" used on Petitioner's labels and packages indicate the particular type and style of cheese put out by Petitioner under said labels. The word "cheddar" means cheese made by the cheddar process, the process used in making so-called American cheese (See Plaintiff's Exhibit 16, App. 45). The word "process" means cheese which is no longer in its original form, but which has been "processed" by grinding it and pasteurizing it at a temperature which will permit it to be poured into any desired shape or size of package (App. 7). See also Government Bulletin, Plaintiff's Exhibit 16, (App. 46) Section 19 of which defines "process cheese." Under U. S. Government regulations, Petitioner's "Old English" cheese, which contains an emulsifier, cannot be called pasteurized cheese, but must be labeled "process cheese" (App. 7 to 8). See also the Bulletin, Sections 18 and 19 (App. 46). See also Snyder's testimony (App. 27 to 28).

7. There is no type of cheese known under the varietal name "English" or "Old English." See Government Bulletin, pages 5 and 6, Plaintiff's Exhibit 16 (App. 45 and 46). See also Riggs' testimony (App. 9 and 10), Snyder's testimony (App. 31), Mulligan's testimony (App. 20). There is no cheese-making process known as the "English Process." (Rigg's testimony, App. 14.) See also John Kraft's testimony (App. 31).

8. The word "old" is not used in selling cheddar or American type cheese to indicate quality, or that the cheese has become well-cured or aged, or has developed a sharp, snappy flavor. On the contrary, the word "old", if used in connection with such cheese, is a derogatory term. Customers never ask for "old cheese" (Mulligan Testimony, App. 21; Riggs Testimony, App. 11 and 12).

9. Since the inception of the use of the brand "Old English" by Petitioner and its predecessors, all of the cheese sold under that name has been manufactured in the United States (App. 10 and 36). No complaint has ever been made by any governmental authority as to false marking or advertising in respect to the place of origin or manufacture, because of the use of the mark "Old English" (App. 25 to 26).

10. Except for Petitioner's cheese, there has never been on the market, in this country, any other cheese known as "Old English" or sold under the brand "Old English," except in the case of a brief minor local infringement in Chicago, Illinois, during the year 1925, which was promptly discontinued after complaint was made (App. 26).

11. The mark "Old English" is used by Petitioner to distinguish its cheese from cheese made by others, and for no other purpose (Riggs App. 13, Mulligan App. p. 21).

12. Petitioner has disclaimed exclusive use of the word "English" apart from the mark "Old English" (App. p. 41).

ARGUMENT.

Proposition No. 1.

The intent of the Trade-Mark Act of 1905 was to afford the fullest possible protection of the property rights of the owner of a common law trade-mark used in Federal commerce.

Although Congress did not define a trade-mark in the Act of 1905, it is recognized that a trade-mark is any word, symbol or other marking which functions "to identify the origin or ownership of the article to which it is affixed." *The "Tea Rose" Case, Hanover Milling Co. v. Metcalf*, 240 U. S. 403, 412.

The plain intent of Congress was not to deny registration of any mark unless the use of it as a trade-mark would not be sanctioned at common law. See *American Foundries v. Robertson*, 269 U. S. 372, 381, where this Court said:

"* * * it reasonably may be assumed, also, that, to the extent the contrary does not appear from the statute, the intention was to allow the registration of such marks as that law, [the substantive law of trade-marks] and the general law of unfair competition of which it is a part, recognized as **legitimate**. The House Committee on Patents, in reporting the bill which upon enactment became the registration statute in question, said: 'Section 5 of the proposed bill we believe will permit the registration of all marks which could, under the common law as expounded by the Courts, be the subject of a trade-mark and become the exclusive property of the party using the same as his trade-mark.' Report No. 3147, Dec. 19, 1904, H. of R., 58th Cong., 3d. Sess."

The 1905 Act should be construed liberally so as to benefit owners of trade-marks by allowing them to register their marks in the United States Patent Office thereby to promote our domestic and foreign trade. See *Beckwith v. Commissioner of Patents*, 252 U. S. 538, 545:

“Of course, refusal to register a mark does not prevent a former user from continuing its use, but it deprives him of the benefits of the statute, **and this should not be done if it can be avoided by fair, even liberal, construction of the act, designed as it is to promote the domestic and foreign trade of our country.**” (Emphasis added.)

Sec. 1 of the 1905 Act (15 U. S. C. 81) says “That the owner of a trade-mark * * * may obtain registration for such trade-mark by complying with the following requirements:” (Here follows a list of the formal requirements.)

An examination of Sec. 5 of the 1905 Act (15 U. S. C. 85) in view of Sec. 1, clearly shows that it was the intention of Congress to permit registration of all trade-marks subject only to certain specific exceptions. These exceptions are types of marks (1) the use of which would be against **public policy** for various reasons, or (2) which members of the public have the natural right to use on the goods, *i. e.*, which in a sense are in the **public domain**.

As examples of the first type referred to, the Act excludes those marks which are immoral or scandalous, or which simulate the flags or insignia of nations or public institutions. As examples of the second type of mark, Congress excludes those marks which are descriptive of the goods or which may be used to indicate the place where the goods were made.

The exceptions listed by Congress are marks which inherently are not good “legitimate” or technical trade-marks at common law.

Hence, it would seem that, in administering the Act, the

Commissioner should give due regard to the purposes of the Act and should permit registration of a fanciful mark **unless it clearly appears** (1) the use of the mark is against public policy or (2) is in the public domain. There is no evidence here that the mark is in either category.

Proposition No. 2.

Exceptions and provisos of a statutory grant expressed in general terms, require the strictest interpretation, and all doubts should be resolved in favor of the one who qualifies under such general grant.

Sec. 5 of the Act says:

“that no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark * * * provided that no mark which consists * * * merely in words or devices which are **descriptive of the goods** with which they are used or of **the character or quality** of such goods or merely a **geographical name or term** * * * shall be registered under the terms of this Act.”
(Emphasis added.)

It is seen that these exceptions are set up in a proviso which follows a general enactment to the effect that **“no mark * * * shall be refused registration as a trade mark on account of the nature of such mark.”** The law is clear that under these circumstances, *i. e.*, where a proviso seeks to except something from the general language of a remedial statute, the proviso should be strictly construed and that the exceptions must be clearly established. See *U. S. v. Dickson* (40 U. S.), 15 Peters 141, 165 (Story, J.):

“* * * we are led to the general rule of law which has always prevailed, and become consecrated almost as a maxim in the interpretation of statutes, that where the enacting clause is general in its language and ob-

jects and a proviso is afterwards introduced, that proviso is construed strictly, and takes no case out of the enacting clause which does not fall fairly within its terms. In short, a proviso carves special exceptions only out of the enacting clause; and *those who set up any such exception, must establish it as being within the words as well as within the reason thereof.*" (Emphasis added.)

Applying these familiar principles, it would seem that unless the mark of applicant, **as an entirety**, is shown by convincing evidence to be descriptive or geographical, it is the duty of the Patent Office to register it.

Proposition No. 3.

The composite mark "Old English" is neither descriptive nor geographical. It is Not in the Public Domain.

Dr. Riggs was asked the question (App. 13):

"Q. Does it (the trade-mark 'Old English') indicate that it is made by some English process?"

This question was finally answered on page 14, when the witness said:

"A. No, because I do not know of any process known as an English process."

The witness, Mulligan (App. 19) was asked the question:

"Q. Does it (the mark 'Old English') convey to you the idea that it is made by some old English process or English process?"

"A. No, sir, I wouldn't say that it does.

"Q. Well, does it convey to you the idea that it is made by the Kraft Cheese Company?"

"A. Mainly, that's the thing; it is a Kraft product.

"By the Court:

"Does it convey to you the idea that it is similar to cheese that formerly was made in England?"

"A. No, sir. It is strictly a trade label to me."

Mr. Snyder (App. 28) testified as follows:

"Q. Now, is there any variety of cheese known as 'English' cheese?

"A. There is not any such variety to my knowledge, and I am sure I would be acquainted with it if there was."

Furthermore, the Government Bulletin (App. 45 and 46) which lists the sixteen principal varieties of cheese known in this country, contains no reference to any cheese known as "English cheese" or to any process known as an "English process."

Hence it is shown that the mark "Old English" does not describe the cheese or the process by which the cheese is made, nor does the mark indicate that the cheese is made in England or in any other locality. Hence, the mark as a whole is not descriptive, nor is it geographical; it is not in the public domain.

Proposition No. 4.

The phrase "Old English" has a recognized dictionary meaning, which is not applicable to cheese, and therefore is purely fanciful.

By reference to page 815 of the Funk & Wagnalls' New Standard Dictionary of the English language, 1929 Edition, Plaintiff's Exhibit 15 (App. 44) it is seen that the words "Old English" are referred to three times as follows:

"In this sense, there are four periods of the history of the English language:

"(a) The period from the earliest Teutonic speech in England, A. D. 450 to A. D. 1150, the Anglo-Saxon period, lately often called Old English.

• • • • •

"(c) the period from 1350 to 1485, the Chaucer

period, the Old English of literature, now often called middle English.

“A type-face resembling German text: more commonly called Old English.”

Thus it appears that, according to the Dictionary, the term “Old English” is used to identify particular periods of early or medieval history of England, and that the term is also used to describe a style of type. The statute, however, does not prohibit the registration of words of historical significance, nor does it prohibit registration of words having only a typographical significance. The Petitioner’s mark is used on cheese, not on history books or on type. As used on cheese the mark is wholly fanciful.

Proposition No. 5.

Under the authorities, “Old English” is a legitimate common law trade-mark for cheese.

“THE AMERICAN GIRL.”

In the case of *Hamilton Brown Shoe Company v. Wolf Bros. & Company*, 240 U. S. 251, the 1905 Act was not specifically involved, but this Court did definitely hold that the trade-mark “THE AMERICAN GIRL” was fanciful, was not descriptive, was not geographical and was inherently a good trade-mark.

It was contended that plaintiff’s recovery was limited because the phrase “THE AMERICAN GIRL” was not inherently a good technical trade-mark. The Supreme Court rejected this contention and specifically ruled that the phrase “THE AMERICAN GIRL” was a good technical common law trade-mark. See page 256:

“We do not regard the words ‘THE AMERICAN GIRL’ adopted and employed by complainant in connection with the shoes of its manufacture as being a geographical or descriptive term. It does not signify that the

shoes are manufactured in America, or intended to be sold or used in America, nor does it indicate the quality or characteristics of the shoes. Indeed, it does not, in its primary signification, indicate shoes at all. It is a fanciful designation, arbitrarily selected by complainant's predecessors to designate shoes of their manufacture."

In the case at bar, as in "THE AMERICAN GIRL" case, the phrase "OLD ENGLISH" is inherently a good technical trade-mark for exactly the same reasons which were assigned by the Supreme Court in the case of "THE AMERICAN GIRL" trade-mark.

"OLD SOUTH."

In *Southeastern Brewing Co. v. Blackwell*, 80 Fed. (2d) 607, 609 (C. C. A. 4) the trade-mark "OLD SOUTH" for beer was held to qualify as a good technical trade-mark, the Court saying:

"As to the first question, the judge below reached the conclusion that the words 'Old South' or 'Old South Brew', taken together do not constitute a term that is geographical or descriptive in its meaning, but rather indicate a regime or period in history, and that therefore the term is capable of appropriation as a trade-mark. In this conclusion we agree." (Emphasis added.)

In reaching that decision, the Court was not influenced by any suggestion of secondary significance developed by long continued use. On the contrary, the use of the mark by the registrant was so recent and so involved in controversy, that one of the judges dissented on the ground that the evidence failed to show first use of the mark.

It is interesting to note that, following the "OLD SOUTH" decision, the Patent Office has issued registrations of the trade-mark "OLD SOUTH", see Plaintiff's Exhibits 17 and 18 (App. 47, 48).

"OLD GERMAN."

In *Gerhard Lang Brewery v. Phoenix Brewery Corporation*, N. Y., 29 T. M. Rep. 439, 444, the Supreme Court of New York, on April 6, 1939, held that the phrase "OLD GERMAN" was not descriptive or geographical:

"I find that the words 'Old German' are not 'geographical' or 'descriptive' in the sense that they preclude appropriation as a trade-name."

On page 445, the Court said:

"* * * that there is nothing descriptive or generic in the words 'Old German'. * * * Those words do not suggest the location of the Lang Brewery in this country or in Germany, nor that the plaintiff's beer resembles that made in any part of Germany; nor do they indicate that 'Lang's Old German' beer is made according to any specific formula or that it has any particular characteristic or quality."

Proposition No. 6.

The Court of Appeals has failed to draw a proper line of distinction between composite words which are registrable, and those which are disqualified for registration.

In this case, the Court of Appeals has dissected the mark into two parts and has then rejected each piece separately. In doing so, the Court has given no consideration to the fanciful meaning of the mark *in its entirety*.

Such piecemeal rejection of a fanciful mark violates the rule laid down by this Court in *Beckwith v. Commissioner of Patents*, 252 U. S. 538, which said (page 545):

"The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason, it should be considered *in its entirety*."

The distinction between composite marks which are registrable and those which are not registrable is derived from the meaning of the mark **in its entirety**. We submit that, in order to determine whether such a mark may be registered, the question should be, "Does the coupling of the two separately unregistrable marks produce a combination or composite mark which **in its entirety** has a fanciful meaning, distinct from the meaning which can be derived from the use of either or both of the separate components?"

For example, take the words "**WISCONSIN CHEDDAR**." Everyone knows that cheese is made in Wisconsin, and that cheddar cheese is a common type of cheese. In the hypothetical mark, "**WISCONSIN CHEDDAR**," the word "**WISCONSIN**" means exactly what it would mean if used in the absence of the word "**CHEDDAR**", and similarly the word "**CHEDDAR**" means a type of cheese, whether it be coupled with the word "**WISCONSIN**" or used separately.

The phrase "**WISCONSIN CHEDDAR**" means cheddar cheese made in Wisconsin, and it is incapable of meaning anything else. It has, and could have, no fanciful meaning and it could not serve to distinguish the cheese of the user from the cheese of others. Thus, it fails to satisfy the initial requirements of Sec. 5, which directs the registration of marks "by which the goods of the owner of the mark may be distinguished from other goods of the same class." Thus it will be seen that the phrase "**WISCONSIN CHEDDAR**" is unregistrable, not because one of its components is geographical and the other is descriptive, but only because the phrase, **in its entirety**, is in the public domain so far as cheese is concerned. It is not a legitimate common law trade-mark for cheese.

On the other hand, the composite mark "**OLD ENGLISH**" does satisfy the requirements of the initial part of Sec. 5

in that **as an entirety**, it has a fanciful meaning not possessed by the separate components, and because it does "serve to distinguish the goods of the owner of the mark . . . from other goods of the same class." In the case of "OLD ENGLISH" the coupling together of the two separately unregistrable words has produced a new fanciful meaning, so that the mark, **in its entirety**, is a legitimate common law trade-mark, it is not geographical or descriptive and is therefore registrable.

CONCLUSION.

To summarize, we submit:

(1) That the evidence shows that the composite mark "Old English" serves to distinguish Petitioner's cheese from that of other manufacturers, and therefore is a good technical common law trade-mark. Whatever descriptive or geographical significance may have been possessed by the separate word "old", or by the separate word "English," as applied to cheese, was destroyed when the separate words were united to form a new and fanciful combination.

(2) That the composite mark qualifies for registration under the general language of section 5, of the 1905 Act, and it is not disqualified by any of the provisos or exceptions contained in said section.

(3) That, in holding that the mark is not registrable under the Act of 1905, the Court of Appeals has misconstrued said Act and the prior decisions of this Court.

(4) That the writ should be granted and the cause reviewed.

Respectfully submitted,

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SECTION 5 OF THE TRADE-MARK ACT OF 1905.

"SEC. 5. U. S. C., title 15, sec. 85. **That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration, as a trade-mark on account of the nature of such mark unless such mark—**

(a) Consists of or comprises immoral or scandalous matter.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, or of any State or municipality or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem, or of any name, distinguishing mark, character, emblem, colors, flag, or banner adopted by any institution, organization, club, or society which was incorporated in any State in the United States prior to the date of the adoption and use by the applicant: **Provided, That said name, distinguishing mark, character, emblem, colors, flag, or banner was adopted and publicly used by said institution, organization, club, or society prior to the date of adoption and use by the applicant: Provided, That trade-marks which are identical with a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers shall not be registered: Provided, That no mark which consists** merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or **merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act: Provided further, * * ***

